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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/588,879	06/06/2000	Nobuyoshi Morimoto	5596-00200	1074
7590	07/13/2005		EXAMINER	
Robert C. Kowert Meyertons, Hood, Kivlin, Kowert & Goetzel P.C. P.O. Box 398 Austin, TX 78767-0398			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/588,879	MORIMOTO, NOBUYOSHI	
	<b>Examiner</b>	<b>Art Unit</b>	
	David E. England	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 31 March 2005.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-37 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-37 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_ .  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_ .



## **DETAILED ACTION**

1. Claims 1 – 37 are presented for examination.

### ***Response to Arguments***

2. In view of the Appeal Brief filed on 03/31/2005, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 15, 19, 29 and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

5. Claims 15, 19, 29 and 37 are not limited to tangible embodiments. In view of Applicant's disclosure, there is no definition for what a carrier medium consists of, only that in the claim language, it comprises program instructions, which is not limited to a tangible embodiment.
6. As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
8. Claims 1 – 11, 15, 16 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claim 1, 15 and 19 recites the limitations of, "storing one or more records in a database, wherein each record comprises an Internet address and a time value, and wherein each record corresponds to a different computer accessing said web site", which does not specify where in the network the database is located or, (i.e., is it located in a server, is it separate from all devices in the network, etc.). Applicant is asked to amend and be more specific because of this ambiguity.
10. Claim 1, 15 and 19 recites the limitation of, "sending a request for information to said first computer, wherein said information comprises a first Internet address and a first time value corresponding to said first computer", which does not say what device is sending said request for

information. Furthermore, if this request is in response to the users first request, that would mean the sending device would have the users Internet address if it was a web request which is standard in TCP/IP in the Web, (source and destination IP addresses in the header). This would raise the question of why would the device need to re-request the Internet address corresponding to said first computer that the user is on if the sending device already has the Internet address and is using that Internet address to send the request. Applicant is asked to explain this scenario or amend the claim language to specify what specific information is being requested.

11. Claim 1, 9, 15, 16 and 19 recites the limitation of, “storing one or more records in a database, wherein each record comprises an Internet address and a time value, and wherein each record corresponds to a different computer accessing said web site” before the limitation of “receiving a first request from a first computer to access the web site; sending a request for information to said first computer, wherein said information comprises a first Internet address and a first time value corresponding to said first computer”. This order seems redundant since the system has just finished the act of “storing” a record which comprises an Internet address and a time value, then sends a request for “information” which is the same as the “record”. Applicant is asked to explain the limitation in regards to the above observation using sections in the specification and drawings or amend the claim language in a proper sequence.

12. Claims 2 – 8, 10 and 11 are rejected for their dependency on claims 1 or 9.

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13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1 – 3, 5, 6, 8, 9, 11, 12, 14 – 16, 18 – 22, 24 – 26, 28 – 31, 33, 34, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton et al. (6418471) (hereinafter Shelton) in view of Holden et al. (6272639) (hereinafter Holden) in further view of Eichstaedt et al. (666230) (hereinafter Eichstaedt).

15. Referencing claim 1, Shelton teaches a method for identifying distinct users accessing a web site, the method comprising:

16. storing one or more records in a database, wherein each record comprises an Internet address and a time value, and wherein each record corresponds to a different computer accessing said web site, (e.g. col. 10, lines 16 – 42);

17. receiving a first request from a first computer to access the web site, (e.g. col. 6, lines 7 – 23);

18. receiving said information, (e.g. col. 6, lines 7 – 23), but does not specifically teach sending a request for information to said first computer, wherein said information comprises a first Internet address and a first time value corresponding to said first computer;

19. determining whether a matching record for said first Internet address and said first time value exists in said database; and

20. identifying said first computer as a distinct user if said matching record does not exist in said database.

21. Holden teaches sending a request for information to said first computer, wherein said information comprises a first Internet address corresponding to said first computer, (e.g. col. 12, lines 17 – 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Holden with Shelton because if a system does not know a computer's address utilizing ARP to query a computer's address is well known in the art and would only take one of ordinary skill to implement.

22. Eichstaedt teaches sending a request for information to said first computer, wherein said information comprises a first Internet address corresponding to said first computer, (e.g. col. 7, lines 23 – 63, "*IP address, deny list*");

23. a first time value, (e.g. col. 7, lines 23 – 63, "*time value t*");

24. determining whether a matching record for said first Internet address and said first time value exists in said database, (e.g. col. 7, lines 23 – 63, "*IP address, time value t, deny list*"); and

25. identifying said first computer as a distinct user if said matching record does not exist in said database, (e.g. col. 7, lines 23 – 63, "*a real user and not a robot*"). It would have been

obvious to one skilled in the art at the time the invention was made to combine Eichstaedt with the combine system of Shelton and Holden because it would be more efficient for a system to update and log users interactions with a web sites which could aid in the determination in trends or stop invalid users, (robots), from accessing site that would require human interaction for payment of services, (example: robot programs buying large quantities of tickets to music venues and selling those tickets illegally at a higher price when the music venue is sold out.

26. As per claim 2, Shelton teaches said time value is associated with a user-defined event, (e.g. col. 10, lines 16 – 42 & col. 10, line 61 – col. 11, line 7).

27. As per claim 3, Shelton teaches said user-defined event is a launch of a web browser software on said first computer system, (e.g. col. 10, lines 16 – 42 & col. 10, line 61 – col. 11, line 7).

28. As per claim 5, Shelton teaches said Internet address is an Internet Protocol (IP) address, (e.g. col. 10, lines 16 – 42 & col. 10, line 61 – col. 11, line 7).

29. As per claim 6, Shelton teaches the database is an object oriented database or a relational database, (e.g. col. 10, lines 16 – 42 & col. 10, line 61 – col. 11, line 7).

30. As per claim 8, Shelton teaches said first computer is a personal computer, a laptop computer, a notebook computer, an Internet-enabled cellular phone, an Internet-enabled personal digital assistant, or an Internet-enabled television, (e.g. col. 1, lines 15 – 45).

31. Claims 9, 11, 12, 14 – 16, 18 – 22, 24 – 26, 28 – 31, 33, 34, 36 and 37 are rejected for similar reasons as stated above.

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32. Claims 4, 7, 10, 13, 17, 23, 27, 32 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton, Holden and Eichstaedt as applied above, and in further view of Bodnar et al. (6295541) (hereinafter Bodnar).

33. As per claim 4, Shelton, Holden and Eichstaedt do not specifically teach said time value is generated by a time keeping device, wherein said time keeping device is configured to synchronize said time value with a global time keeping standard clock. Bodnar teaches said time value is generated by a time keeping device, wherein said time keeping device is configured to synchronize said time value with a global time keeping standard clock, (e.g. col. 9, lines 19 – 60 & col. 25, line 52 – col. 26, line 20). It would have been obvious to one skilled in the art at the time the invention was made to combine Bodnar with the combine system of Shelton, Holden and Eichstaedt because it would be more efficient for a system to have a standard clock set to monitor users in trends in users accessing the web site and when the most users access the web site at a time, (peak time), and adjust the web site to accommodate the users as such.

34. As per claim 7, Shelton, Holden and Eichstaedt teach all that is described above but does not specifically teach said timestamp for said matching record is older than a predetermined maximum time. Bodnar said timestamp for said matching record is older than a predetermined maximum time, (e.g. col. 27, line 40 – col. 28, line 31). It would have been obvious to one skilled in the art at the time the invention was made to combine Bodnar with the combine system of Shelton, Holden and Eichstaedt because it would be more efficient for a system to update the database after a predetermined max time so to have a dynamic database that would never have

information that is older then the predetermined max time which would aid in the determination of user trends in close to real-time data.

35. Claims 10, 13, 17, 23, 27, 32 and 35 are rejected for similar reasons as stated above.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England  
Examiner  
Art Unit 2143

De *DE*



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